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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,614	10/31/2003	Andrew W. Marsden	20341-72636	9862

23643 7590 03/27/2006

BARNES & THORNBURG
11 SOUTH MERIDIAN
INDIANAPOLIS, IN 46204

EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,614

Applicant(s)

MARSDEN ET AL.

Examiner

James N. Smalley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-36 is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 37 is/are rejected.
- 7) ☒ Claim(s) 12-14 and 26-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Due to the new grounds of rejection, this action is made Non-Final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maze US 5,238,140 in view of Henin US 2,404,496 and in view of Carpinella US 5,686,700.

Maze '140 teaches a container with a spout (32) and medicine container (18) with lid (26). The lid pivots about the axis at the point of attachment of the tether (126a) with the top surface of the lid.

First, Maze '140 does not teach the container having an open mouth, instead disclosing a lid which is integral to the container.

Henin '496 teaches it is known to provide a lid on an open container.

It would have been obvious to provide the lid of Maze '140 as a separate element on an open ended container, as taught to be known by Henin '496, because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, Examiner notes that although Maze '140 teaches a "peanut-shaped" container, Examiner asserts one of ordinary skill would still find it obvious to provide the lid as a separate element in view of the teaching of Henin '496, even though the Henin '496 container is circular. Examiner notes Henin '496 discloses what appears to be a friction fit connection. It would be obvious to apply the lid through such a connection, though it would not be obvious to apply it as a threaded connection.

Secondly, Maze '140 does not teach a lid mounted for movement below the spout and above the top wall.

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Carpinella '700 teaches a closure (24) with alignable openings (18) and (26) which pivots in a plane flush with surface (46) and above top wall (14). Such a closure is a mechanical expedient of that taught by Maze '140 because both serve to selectively open and seal a container opening port.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the medicine container closure of Maze '140, providing the pivoting closure taught by Carpinella '700, because such is an alternative closure equally capable of opening and closing off a container.

4. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maze US 5,238,140 in view of Bilson US 3,490,290.

Maze '140 does not teach a tiered medicine container, but does teach container (118) provided with graduated measurement indicia.

Bilson '290 teaches a tiered container for measuring.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure of Maze '140, replacing the measuring container with the tiered measuring container taught by Bilson '290 because the two are equally capable of indicating a desired volume.

Allowable Subject Matter

5. Claims 30-36 are allowed.

6. Claims 12-14 and 26-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns



Stephen K. Cronin
Primary Examiner